

REMARKS

Claims 25-32, 34-43 and 45-48 are pending in the present application. Claims 25 and 37 were amended in this response. Claims 33 and 44 were canceled, without prejudice. Favorable reconsideration is respectfully requested.

Claims 25 and 27-32, 36-37, 40-43 and 47-48 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Gilhousen et al.* (US Patent 5,603,096 – hereafter “*Gilhousen I*”) in view of *Gilhousen et al.* (US Patent 5,280,472 - hereafter “*Gilhousen II*”).

Claims 26, 38 and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Gilhousen et al.* (US Patent 5,603,096 – hereafter “*Gilhousen I*”) in view of *Gilhousen et al.* (US Patent 5,280,472 - hereafter “*Gilhousen II*”) and further in view of *Takayama et al.* (US Patent 5,982,294).

Claims 33-35 and 44-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Gilhousen et al.* (US Patent 5,603,096 – hereafter “*Gilhousen I*”) in view of *Gilhousen et al.* (US Patent 5,280,472 - hereafter “*Gilhousen II*”) and further in view of *Raith* (US Patent 5,751,731). Applicants traverse these rejections. Favorable reconsideration is respectfully requested.

Specifically, the cited art, alone or in combination, fails to teach that “during the coding process, at least one bit in the coded data word is assigned a value which corresponds to a logic operation between the power control information to be transmitted in the corresponding time slot and the information to be transmitted in the same time slot from the further data” as recited in claim 33 and similarly recited in claim 44.

Regarding *Raith*, the reference teaches a decoding strategy for a codeword where received check bits may be inverted and an exclusive OR function is performed on a “predicted” SFP value which is determined from the mobile's internal clock where the sequence 1,1,1,1,1 and the result is encoded into a 12-bit codeword. An exclusive OR function is then performed on these two 12-bit vectors (i.e., the received CSFP/PCF field and the codeword produced from the “predicted” SFP value) to remove the check bits from the superframe phase (SFP) (col. 12, lines 26-43, see claim 5). The purpose of this is to determine whether or not reserved bits of a field are assigned a function so that the mobile station may easily be adapted to perform enhanced functions, where first generation mobile stations are able to perform enhanced functions using

bits which are initially reserved but may be assigned to service or function in later generations of the protocols (see Abstract). Furthermore, as *Raith* relies on a predicted value, it fails to teach a value which corresponds to a logic operation between the power control information (which is a function of a signal) to be transmitted in the corresponding time slot and the information to be transmitted in the same time slot from the further data.

Moreover, there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine *Raith* with the *Gilhousen I* and *Gilhousen II* references in the manner suggested in the Office Action. In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-


obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Raith explicitly teaches that the exclusive OR operation is conducted in furtherance of determining whether or not reserved bits are assigned functions (see Abstract). In contrast, both *Gilhousen I* and *Gilhousen II* teach that puncturing occurs within a data word and that added bits are inserted in a random fashion (*Gilhousen I*, col. 5, lines 31-40; *Gilhousen II*, col. 22, lines 35-40). For at least these reasons, Applicant respectfully submits the rejections under 35 U.S.C. §102 and §103 are traversed and should be withdrawn.

In light of the above remarks, Applicant respectfully submit that claims 25-32, 34-43 and 45-48 are allowable. Applicants respectfully submit that the patent application is in condition for allowance and request a Notice of Allowance be issued. The Commissioner is authorized to charge and credit Deposit Account No. 02-1818 for any additional fees associated with the submission of this Response. Please reference docket number 112740-344.

Respectfully submitted,

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